



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,740	03/04/2005	Eliezer Peli	ERI-131XX	7880

207 7590 09/26/2008
WEINGARTEN, SCHURGIN, GAGNEBIN & LEOVICI LLP
TEN POST OFFICE SQUARE
BOSTON, MA 02109

EXAMINER

WILLSE, DAVID H

ART UNIT	PAPER NUMBER
----------	--------------

3738

MAIL DATE	DELIVERY MODE
-----------	---------------

09/26/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/526,740	Applicant(s) PELI, ELIEZER	
	Examiner Dave Willse	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3-23-06; 8-8-07; 10-19-07</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3738

The abstract of the disclosure is objected to because it must be provided on a separate sheet. Correction is required. Reference is made to MPEP § 608.01(b).

The disclosure is objected to because of the following informalities: On page 5, line 7, “task” should be replaced by --tasks--. On page 12, line 30, “bottom” should apparently read --top--: attention is directed to page 13, lines 5-6, for comparison. On page 14, lines 16 and 22, “blank” (both occurrences) is misspelled. In claim 25, line 8, the second comma should be deleted. Appropriate correction is required.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8, 9, 12-17, and 31-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 8, line 2, “said carrier lens” lacks a proper antecedent basis. Similar problems occur in claims 15-17. In claims 12-14, line 2 of each, “said spectacle carrier lens” lacks a proper antecedent basis. In claim 31, lines 1-2, “said first region of said first region” renders claims 31-33 vague and confusing as to the scope.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

Art Unit: 3738

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 7, 8, 10-12, 15-17, 19, and 20 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Sekine, JP 55-74513 A, which discloses a first optical element in the form of a contact lens **6** in optical communication with a second optical element **2** so as to provide a substantially standard distance correction and a magnified focused retinal image (English abstract, particularly the last two sentences).

Claims 4-6, 18, 21, and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sekine, JP 55-74513 A. Regarding claims 4, 5, and others, optical powers within the specified ranges would have been obvious to the ordinary practitioner in order to meet the prescriptions for a diversity of patients and/or to adapt the lens system for purposes requiring varied magnifications. Regarding claim 6, the main lens of second optical element **2** having an optical power substantially equal to zero would likewise have been obvious in order to permit the patient to remove the spectacles without appreciably compromising acuity of vision via the contact lens **6**. Regarding claim 18, replacing the contact lens **6** with an intraocular lens would have been an obvious modification in order to eliminate the need to clean and/or replace contact lenses on a frequent basis and/or in order to provide a more appropriate lens system where an intraocular lens is otherwise indicated for a particular patient. The system of instant claim 21 would have been obvious in order to present for one eye the sort of correction to which the patient is accustomed so as to impart a clearer wide-angle view.

Claims 1-13, 15-17, 19-30, 34-37, 39-41, and 43-45 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Filderman, US 3,027,803, which illustrates a first optical element in the form of a contact lens **10** including an outer annular region and an inner region **D₃**

Art Unit: 3738

(drawing; column 2, line 34 et seq.) and a second optical element in the form of a spectacle lens (column 2, line 59 et seq.) including a second portion **D₄** having an optical power selected in conjunction with the inner region **D₃** to provide a magnified focused retinal image (column 3, line 50 et seq.). Regarding claim 6 and others, attention is directed to column 1, lines 35-39, for example; the Applicant may wish to replace “second” with --first-- on line 4 of claim 6 for improved clarity as to the scope. Regarding claims 12 and 13: column 4, lines 2-4; etc. Regarding claims 20 and 21, reference is made to column 4, lines 5-16. Regarding claim 22, Filderman additionally teaches a third region including “segment **L₃** having the proper reading addition as prescribed” (column 3, lines 70-72).

Claims 18, 42, and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Filderman, US 3,027,803. Replacing the contact lens **10** with an intraocular lens would have been obvious for reasons given above.

Claims 14, 31-33, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Filderman, US 3,027,803, in view of Graham, US 6,027,214. Regarding claims 14 and 38, supplemental lenses inserted into spectacle carrier lenses were well known in the art at the time of the present invention and would have been an obvious variant on the cementing or molding mentioned by Filderman (column 2, lines 59-69; column 3, lines 66-69; column 4, lines 2-4) in view of the advantages of readily attachable and detachable lenses as known to the ordinary practitioner (e.g., Graham: column 8, lines 22-27), and such a modification would have led to nothing more than predictable results because the lens arrangements and optical effects are essentially the same. Regarding claim 31, a middle region providing standard distance correction, an upper region magnifying a distant object, and a lower region imparting short

Art Unit: 3738

reading distance magnification would have been obvious for specialized occupational applications that require reading/magnification in an *upper* region of the lens (Graham: column 1, lines 43-49; column 3, lines 44-48; column 4, lines 22-24; column 7, lines 24-26). Regarding claims 32 and 33, horizontally elongated configurations would have been obvious from the drawings of Graham and from the common shapes of spectacle lenses.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse, whose telephone number is 571-272-4762 and who is generally available Monday, Tuesday, and Thursday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

**/Dave Willse/
Primary Examiner
Art Unit 3738**